

REMARKS

I. Status of the Claims

Applicant submits this Amendment in reply to the Office Action dated January 8, 2009. Claims 1-3, 6, 8, 9, 14, 17, 22, 28-34, 36-42, 45-53, 60-64, 66-76 are the pending, non-withdrawn claims in this application, with claims 1, 22, 36, 49, 60, 61, 62, and 66 being independent. By this Amendment, Applicant has amended claims 1, 22, 36, 49, 60, 61, 62, and 66. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of the amended claims, and no new matter has been entered.

As an initial matter, Applicant would like to thank Examiner McEvoy for the courtesy of the telephone interview conducted with Applicant's representatives on March 17, 2009. In the interview, the Examiner's interpretation of the applied references and the claims, particularly independent claims 1, 22, 36, 49, 60, 61, 62, and 66 and dependent claims 14 and 50, were discussed. Proposed amendments to claims 1, 22, 36, 49, 60, 61, 62, and 66 were also discussed. The Examiner agreed that the proposed amendments, now reflected in amended independent claims 1, 22, 36, 49, 60, 61, 62, and 66, were supported by the original disclosure and overcome the applied references. Accordingly, independent claims 1, 22, 36, 49, 60, 61, 62, and 66, and its dependents claims, are allowable over the applied references.

In the Office Action, claims 1-3, 6, 8, 9, 14, 36-42, 45, 47, 48, 61, 62, and 68 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,274,269 to Jellinek ("*Jellinek*"), and claim 61 is rejected under 35 U.S.C. §102(b) as being

anticipated by U.S. Patent No. 4,543, 695 to Dorsey ("*Dorsey*"). In addition, claims 22, 28-34, 46, 49-53, 63, 64, 69-72, 74, and 75 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Jellinek* in view of U.S. Patent No. 5,253,366 to Marlo et al. ("*Marlo*"). Moreover, claims 60, 66, 67, 73, and 76 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Jellinek* in view *Marlo* and/or U.S. Patent No. 2,248,100 to Loebich ("*Otto*"). Claims 60 and 66 are also rejected under 35 U.S.C. §103(a) as being unpatentable over *Dorsey* in view of *Otto*. In so far as the Examiner deems the rejections to apply to the claims as amended, Applicant respectfully traverses for at least the following reasons.

II. The Rejections Under 35 U.S.C. §102(b)

Independent claims 1, 36, 61, and 62 each recites, among other things, a device for treating a body canal comprising a proximal end-piece, a distal end-piece, and an elongated body portion between the proximal and distal end pieces, the body portion including "a plurality of interconnected loops directly connected to the proximal end-piece and the distal end-piece."

Jellinek discloses a device for attaching jewelry such as brooches, pins, and clips to be worn as a pendant. As shown in Fig. 3 (a figure referred to in the rejection), for example, the device includes a sleeve 2 and an ornamental chain 5 secured to the top face of sleeve 2. A pin member 13 of an ornamental brooch B is disposed within sleeve 2, with a projecting member 10 and a safety catch 14 securing pin member 13 to brooch B. In rejecting claims 1, 36, 61, and 62, the Office Action appears to rely on sleeve 2 as

allegedly corresponding to the claimed “non-looped segment,” ornamental chain 5 as allegedly corresponding to the claimed “interconnected loops,” safety catch 14 as allegedly corresponding to the claimed “proximal end-piece,” and projecting member 10 as allegedly corresponding to the claimed “distal end-piece.” (Office Action at pp. 2-3.) Even assuming the Office Action’s characterizations are correct, which Applicant does not concede, *Jellinek* fails to teach or suggest “a plurality of interconnected loops directly connected to the proximal end-piece and the distal end-piece,” as recited in claims 1, 61, and 62. In contrast, *Jellinek* discloses that ornamental chain 5 is “secured to the top face of sleeve 2” (*Jellinek*, col. 2, lines 29-34) and not “directly connected” to projecting member 10 and safety catch 14.

Dorsey discloses a jewelry clutch comprising a tubular shell 10 having a resilient clutch member 22 and a stud 24b adapted to be received within the resilient member 22. As shown in Fig. 8 (a figure referred to in the rejection), for example, stud 24b is inserted into resilient clutch member 22 to create an airtight joint. A chain is coupled to one end of the stud 24b and one end of the tubular shell 10. In rejecting claim 61, the Office Action appears to rely on an intermediate portion of stud 24b as allegedly corresponding to the claimed “non-looped section,” tubular shell 10 and a terminal end of stud 24b as allegedly corresponding to the claimed proximal and distal end-pieces, and the chain as allegedly corresponding to the claimed “interconnected loops.” (Office Action at pp. 3-4.) Even assuming the Office Action’s characterizations are correct, which Applicant does not concede, *Dorsey* fails to teach or suggest “a plurality of interconnected loops directly connected to the proximal end-piece and the distal end-

piece,” as recited in claim 61. In contrast, and as shown in Figs. 1-4 of *Dorsey*, for example, “a chain 28 may be soldered or otherwise affixed” to a rearward portion of the stud (allegedly corresponding to the claimed non-looped segment) and tubular member 10 (allegedly corresponding to a claimed end-piece); however, no portion of chain 28 is connected to blunt nose 25 (allegedly corresponding to the other claimed end-piece). (*Dorsey*, col. 2, lines 53-55.)

For at least these reasons, *Jellinek* and *Dorsey* do not anticipate claims 1, 36, 61, and 62, and Applicant respectfully requests withdrawal of the Section 102 rejection based on *Jellinek* and *Dorsey*.

Dependent claims 2, 3, 6, 8, 9, 14, 37-42, 45, 47, 48, and 68 depend either directly or indirectly from either claim 1, 36, or 61 and are patentable for at least the same reasons. In addition, these dependent claims recite unique combinations that are neither taught nor suggested by *Jellinek* and *Dorsey*, and therefore also are separately patentable for these recitations.

For example, *Jellinek* and *Dorsey* fail to disclose, and the Office Action fails to address, the feature of dependent claim 14. *Jellinek* and *Dorsey* fail to teach or suggest “a surface of said segment is uneven.” In contrast, sleeve 2 of *Jellinek* (allegedly corresponding to the claimed non-looped segment) is merely described as “a tubular member” (*Jellinek*, col. 2, lines 20-21) with no teaching or suggestion of an uneven surface, as recited in claim 14.

III. 35 U.S.C. §103(a) Rejections

Independent claims 22, 49, 60, and 66 each includes similar recitations as those discussed above with respect to independent claims 1, 36, 61, and 62 and are patentably distinguishable from *Jellineck* and *Dorsey* for at least the same reasons as discussed above.

In rejecting claims 22, 49, 60, and 66, the Office Action relies on teachings of *Marlo* and *Otto* for certain features of those claims which are neither taught nor suggested by *Jellineck* and *Dorsey*. For example, the Office Action relies on *Marlo* for its alleged teaching of spherical end-pieces, as recited in claims 22 and 49 (Office Action at p. 5), and *Otto* for its alleged teaching of a "bioerodible/biodegradable material," as recited in claims 60 and 66. (Office Action at pp. 5-6.)

Even assuming the Office Action's characterizations of *Marlo* and *Otto* are correct, which Applicant does not concede, *Otto* and *Marlo* fail to cure the deficiencies of *Jellineck* and *Dorsey*. *Otto* and *Marlo*, like *Jellinek* and *Dorsey*, do not disclose or suggest "a plurality of interconnected loops directly connected to the proximal end-piece and the distal end-piece," as recited in claims 22, 49, 60, and 66. It is therefore requested that the rejection of independent claims 22, 49, 60, and 66 under 35 U.S.C. §103(a) based on any combination of *Jellinek*, *Dorsey*, *Marlo*, and *Otto* be withdrawn, and that these independent claims be allowed.

Dependent claims 28-34, 46, 67, 70, 72-73, and 76 depend either directly or indirectly from either claim 22, 49, 60, and 66 and are patentable for at least the same

reasons. In addition, these dependent claims recite unique combinations that are neither taught nor suggested by the cited references, and therefore also are separately patentable for these recitations.

For example, the cited references fail to teach or suggest that “a surface of the segment is uneven,” as recited in dependent claim 50.

Moreover, the rejections based on any of *Jellinek*, *Dorsey*, *Marlo*, and *Otto* are improper because none of the cited references are analogous to the art of medical devices.

According to the M.P.E.P., a reference in a field different from that of an Applicant’s invention, used as a basis for rejection, “may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his or her invention as a whole.” M.P.E.P., § 2141.01(a)(I) *citing KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007).

The jewelry attachment disclosed by *Jellinek* is used to transform articles of jewelry into a pendant and the article of jewelry disclosed by *Dorsey* is used as an ornamental design to be worn on the body. The device disclosed in *Marlo* provides a structure for retaining the knot of a necktie and the jewel disclosed in *Otto* includes a mixture of alloys to prevent corrosion of the jewel. The jewelry attachment of *Jellinek*, the article of jewelry of *Dorsey*, the *Marlo* device, and the jewel of *Otto* clearly are not, however, in the field of Applicant’s endeavor because, for example, none of the disclosed devices are medical devices, are designed to be implanted in a patient’s body

canal, or are designed to minimize and preserve contact with the lining of the body canal.

Moreover, one of ordinary skill in the art seeking to solve the problems or difficulties associated with maintaining the patency of a body canal while simultaneously minimizing contact with the lining of the body canal would not have looked to the arts of jewelry or neckties. In particular, the problems associated with transforming articles of jewelry into pendants (*Jellinek*), wearing an article of jewelry (*Dorsey*), retaining a knot of a necktie (*Marlo*), and preventing corrosion of a jewel (*Otto*) are significantly different than and not reasonably pertinent to the field of medical devices and the problems associated with treating a body canal and thus one of ordinary skill in the art would not have been reasonably expected or motivated to look to these references.

The Office Action asserts that “[t]he scope of Applicant’s claims are directed to treatment of any body canal. This does not limit the scope of the claims to medical devices. Any mechanical device can be used to treat a body canal, either interiorly or exteriorly.” (Office Action at p. 7.) In light of this assertion, Applicant has amended each of independent claims 1, 22, 36, 49, 60, 61, 62, and 66 to specifically recite a medical device.

For at least this additional reason, the section 103 rejections based on any of *Jellinek*, *Dorsey*, *Marlo*, and *Otto* are improper and reconsideration is respectfully requested.

IV. Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

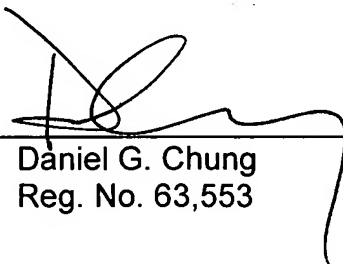
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 8, 2009

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